### REMARKS

By this Amendment, Applicant has canceled claim 2 without prejudice or disclaimer of the subject matter recited therein, and amended claims 1, 3, and 4 to more appropriately define the invention.

In the Office Action dated August 11, 2004, the Examiner: objected to the Oath/Declaration; rejected claims 1, 2, 4, and 6 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,073,195 ("Okada"); and rejected claims 3, 5, and 7 under 35 U.S.C. § 103(a) as unpatentable over Okada in view of U.S. Patent No. 5,884,053 ("Clouser").

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants declines to automatically subscribe to any statement or characterization in the Office Action.

#### OATH/DECLARATION

Applicant respectfully traverses the objection to the Oath/Declaration. The Office Action Summary indicates that the Examiner objects to the Oath/Declaration, but the Detailed Action fails to provide a reason for the objection. Accordingly, Applicant assumes the objection was a typographical error.

#### CLAIM 1

Applicant respectfully traverses the rejection of claim 1 under 35 U.S.C. § 102(e) as anticipated by *Okada* because the cited reference fails to teach each and every element of amended claim 1. M.P.E.P. § 2131 (8th Ed. May 2004).

Particularly, *Okada* fails to teach at least a second board including a third transmission line that is connected to a first transmission line through a second connector and to which a dummy load on the second board, having an impedance, is connected, such that the impedance of the dummy load is equal to the impedance of a element on a first board and the first and second boards are detachable from a system board. *Okada* merely describes a bus connector 12 in Fig. 1, composed of a switch 22 and a dummy load 24 in Fig. 2. (Col. 4, lines 1-2). Dummy load 24 is not part of a detachable board and does not have an impedance equal to the impedance of an element on another detachable board.

Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(e) as anticipated by Okada should be withdrawn and claim 1 should be allowed.

# CLAIM 2

Applicant respectfully traverses the rejection of claim 2 under 35 U.S.C. § 102(e) as anticipated by *Okada*. However, in order to advance the prosecution of this case, Applicant has canceled claim 2 without prejudice or disclaimer of the subject matter recited therein. Accordingly, the rejection of claim 2 is moot.

Applicant reserves the right to pursue the subject matter contained in claim 2 at a later time in the present application or another application (e.g., a continuation application).

#### CLAIM 3

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. § 103(a) as unpatentable over *Okada* in view of *Clouser* because the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, the prior art reference must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference in a manner resulting in the claimed invention. M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. M.P.E.P. § 2143.02. Moreover, each of these requirements must "be found in the prior art, and not based on applicant's disclosure." M.P.E.P. § 2143. In rejecting claim 3, the Examiner has failed to establish a *prima facie* case of obviousness.

Particularly, *Okada* and *Clouser* separately or in combination, fail to teach or suggest each and every element recited in the claim. Claim 3 depends upon allowable claim 1 and includes all elements recited in claim 1. As discussed above for claim 1, *Okada* fails to teach at least a second board including a third transmission line that is connected to a first transmission line through a second connector and to which a dummy load on the second board, having an impedance, is connected, such that the impedance of the dummy load is equal to the impedance of a element on a first board and the first and second boards are detachable from a system board.

Clouser fails to overcome the deficiencies of Okada. Clouser merely discloses a dummy load card to be installed in a slot 604 not occupied by a real adapter. (Col. 7, lines 5-6). This is not the same as a second board including a third transmission line that is connected to a first transmission line through a second connector and to which a dummy load on the second board, having an impedance, is connected, such that the impedance of the dummy load is equal to the impedance of a element on a first board

and the first and second boards are detachable from a system board. Hence, *Okada* and *Clouser* separately or in combination, fail to teach or suggest each and every element recited in the claim.

Further, *Clouser* specifically teaches away from installing a dummy load in a slot 604 not occupied by a real adapter. (Col. 7, lines 10-15). Hence, *Clouser* cannot be combined with the disclosure of *Okada* to yield:

A computer system comprising a system board including a first connector and a second connector arranged in parallel with a first transmission line connecting at least one element on the system board;

a first board including a second transmission line that is connected to the first transmission line through the first connector and to which an element, on the first board, having an impedance is connected; and

a second board including a third transmission line that is connected to the first transmission line through the second connector and to which a dummy load on the second board, having an impedance, is connected,

wherein the impedance of the dummy load is equal to the impedance of the element on the first board and the first and second boards are detachable from the system board.

Accordingly, the rejection of claim 3 under 35 U.S.C. § 103(a) should be withdrawn and claim 3 should be allowed.

### CLAIM 4

Applicant respectfully traverses the rejection of claim 4 under 35 U.S.C. § 102(e) as anticipated by *Okada* because the cited reference fails to teach each and every element in amended claim 4.

Particularly, *Okada* fails to teach at least a first board that is detachable from a system board and connected through a connector, such that an impedance matching

element, on the system board, for impedance matching of a transmission line of the system board is connected to the transmission line when the first board is connected. *Okada* merely discloses a bus connector composed of a switch 22 and a dummy load 24. (Col. 4, lines 1-2). Switch 22 selects bus agent 16<sub>1</sub> or a dummy load for connection to bus 10. (Col. 3, lines 3-4). Bus agent 16<sub>1</sub> may be a hard disk drive, a flexible disk drive, or a modem. (Col. 3, lines 25-27). This is not the same as having an impedance element on a system board connected to the transmission line of the system board when the first board is connected to the system board through the connector.

Accordingly, the rejection of claim 4 under 35 U.S.C. § 102(e) as anticipated by Okada should be withdrawn and claim 4 should be allowed.

# CLAIM 5

Applicant respectfully traverses the rejection of claim 5 under 35 U.S.C. § 103(a) as unpatentable over *Okada* in view of *Clouser* because the Examiner has failed to establish a *prima facie* case of obviousness.

Particularly, *Okada* and *Clouser* separately or in combination, fail to teach or suggest each and every element recited in the claim. Claim 5 depends upon claim 4 and includes all elements recited in claim 4. As discussed above for claim 4, *Okada* fails to teach at least a first board that is detachable from a system board and connected through a connector, such that an impedance matching element, on the system board, for impedance matching of a transmission line of the system board is connected to the transmission line when the first board is connected. *Clouser* fails to overcome the deficiencies of *Okada* because *Clouser* merely discloses a dummy load card to be installed in a slot 604 not occupied by a real adapter. (Col. 7, lines 5-6). This

is not the same as having an impedance element on a system board connected to the transmission line of the system board when the first board is connected to the system board through the connector.

Accordingly, the rejection of claim 5 under 35 U.S.C. § 103(a) as unpatentable over *Okada* in view of *Clouser* should be withdrawn and claim 5 should be allowed.

# **CLAIM 6**

Applicant respectfully traverses the rejection of claim 6 under 35 U.S.C. § 102(e) as anticipated by *Okada* because the cited reference fails to teach each and every element in amended claim 6.

Particularly, *Okada* fails to teach at least an impedance matching element having an impedance which is equal to that of an expansion board. *Okada* merely discloses a bus connector composed of a switch 22 and a dummy load 24. Switch 22 selects bus agent 16<sub>1</sub> or a dummy load for connection to bus 10. Bus agent 16<sub>1</sub> may be a hard disk drive, a flexible disk drive, or a modem. This is not the same as a connector including at least an impedance matching element having an impedance which is equal to that of an expansion board.

Accordingly, the rejection of claim 6 under 35 U.S.C. § 102(e) as anticipated by Okada should be withdrawn and claim 6 should be allowed.

### CLAIM 7

Applicant respectfully traverses the rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over *Okada* in view of *Clouser* because the Examiner has failed to establish a *prima facie* case of obviousness.

Particularly, *Okada* and *Clouser* separately or in combination, fail to teach or suggest each and every element recited in the claim. Claim 7 depends upon claim 6 and includes all elements recited in claim 6. As discussed above for claim 6, *Okada* fails to teach at least an impedance matching element having an impedance which is equal to that of an expansion board. *Clouser* fails to overcome the deficiencies of *Okada* because *Clouser* merely discloses a dummy load card to be installed in a slot 604 not occupied by a real adapter. (Col. 7, lines 5-6). This is not the same as a connector including at least an impedance matching element having an impedance

Accordingly, the rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over *Okada* in view of *Clouser* should be withdrawn and claim 7 should be allowed.

# **CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: November 11, 2004

which is equal to that of an expansion board.

<sup>\*</sup>Kenie Ho

Reg. No. 51,808